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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,780	04/12/2001	Domingo Figueras Payas	2136/0J098	9468

7590 02/25/2003
DARBY & DARBY P.C.
805 Third Avenue
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EXAMINER

CULLER, JILL E

ART UNIT PAPER NUMBER

2854

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,780

Applicant(s)

FIGUERAS PAYAS, DOMINGO

Examiner

Jill E. Culler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/27/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/12/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the methods of displacing sheets for printing off-center text as described in claims 6-8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 1-8 are objected to because of the following informalities:

In claim 1, on line 11, the word "therefor" should be "therefore".

Claim 3 recites the limitation "externally operated electronic controller" in line 4. There is insufficient antecedent basis for this limitation in the claim. Although claim 1 recites an electronic controller there is no indication that this controller is externally operated and it is therefore unclear whether this additional limitation is being claimed.

Claim 8 recites the limitation "the off-centre arrangement of one of the edges" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear what form the base for carrying paper takes, for example, whether it is feeding the sheets to the printing apparatus or supporting the sheets during the printing process. Since the scope of the claim cannot be reasonably determined, prior art cannot be applied to the claims to evaluate whether or not it is patentable.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to Claim 2, it is not clear what is meant by "standard size" since what is 'standard' may be different to different people.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 452,933 to Feister in view of EPO 0895183 and U.S. Patent No. 3,593,987 to Garber.

Feister shows a printing and binding machine for the preparation of books which includes unrolling a sheet of paper and cutting it prior to printing, see lines 22-24, then printing on one side of the sheet and then the other, see lines 24-26, then folding the sheets about an axis of symmetry, see lines 33-34, and trimming the sheets, 34-35, to finish the text.

Feister does not teach an electronic printing machine having a memory for the content of the texts of the various pages and electronically controllable means for determining the surface area occupied by the text and the parameters defining the text, or printing the text symmetrically, varying the extent of the body of text for each page in accordance with the dimensions provided. Feister also does not discuss cutting the sheets at the outer edges or joining and binding the sets of sheets. Feister does not discuss that the adjustment of the parameters determining the texts and the arrangement on the sheet is effected by externally operated electronic controls of the

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printer without stopping the continuous process of manufacture. Feister also does not teach that each sheet is printed in an off-center manner to produce a lateral edge strip which is parallel with one of the edges.

EPO 0895183 teaches an electronic printing machine, having a memory for the content of the texts of the various pages and electronically-controllable means for determining the surface area occupied by the text and the parameters defining the text, and teaches that the text is printed symmetrically, varying the extent of the body of text for each page in accordance with the dimensions provided, and that the adjustment of the parameters determining the texts and the arrangement on the sheet is effected by externally operated controls of the printer without stopping the continuous process of manufacture and that each sheet is printed in an off-center manner to produce a lateral edge strip which is parallel with one of the edges.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the printing machine of Feister with the electronic controls of EPO 0895183 in order to have better control over the printing process and the distribution of the text on the sheets.

Garber teaches a printing process in which the sheets are folded to form signatures, see column 3, lines 70-72, then a plurality of these signatures are bound together and trimmed. See column 4, lines 33-35.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the printing machine of Feister to fold before binding since Garber teaches that this is an advantageous method of creating a book.

With respect to claim 2, any sheet may be considered to be standard size for a particular printing apparatus or process.

With respect to claim 4, the claimed product results from the process as already discussed.

Response to Arguments

9. Applicant's arguments filed 11/27/02 have been fully considered but they are not persuasive.

With respect to the drawing objection, although the displacement of the actual text is shown in Figs. 8-11, the methods of displacing the sheets, as recited in claims 6-8, are not shown in any of the figures.

With respect to the claim objections, the antecedent basis objections for claims 3 and 8 were not overcome by the amendments.

With respect to the rejection of claims 6-8 under 35 U.S.C. 112, first paragraph, the recitation in the specification of "the base carrying the sheets with respect to the printing means of the machine" is not sufficient to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Therefore, without further description of the apparatus, the claims cannot be evaluated.

With respect to the rejection of claim 2 under 35 U.S.C. 112, second paragraph, standard size sheets in the U.S. do not conform to the DIN or ISO standards as recited. Therefore, this limitation cannot reasonably be assumed without further clarification in the claim.

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With respect to the argument that the applied references do not suggest printing bodies of text with a symmetrical distribution as claimed, in Feister, on page 1, lines 33-34, discusses folding sheets through their center margin. This can reasonably be interpreted to imply that the text on the sheets is printed with a symmetrical distribution with respect to this center fold as a center of symmetry of the sheet being printed.

With respect to the argument that Yasuo does not teach or suggest the use of a surface with four printing areas per face, forming logical groups of pages for the manufacture of books, this is not explicitly claimed.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The rejection is over Feister in view of Yasuo and Yasuo is only relied upon for the teaching of an electronic controller in combination with the invention of Feister, not for the limitations being argued.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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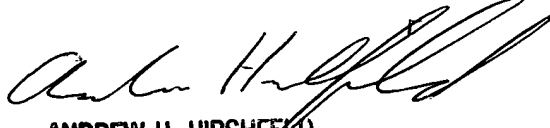
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (703) 308-1413. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

jec
February 20, 2003


ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
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